



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,018	12/27/2001	Emile Di Serio	1759.066	9212

7590 10/20/2006

HESLIN ROTHENBERG FARLEY & MESITI, P.C.
5 Columbia Circle
Albany, NY 12203

EXAMINER

LARSON, LOWELL A

ART UNIT PAPER NUMBER

3725

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,018

Applicant(s)

SERIO, EMILE DI

Examiner

Lowell A. Larson

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 1 and 3 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Mikito in view of admitted prior art and Hiroshi for the reasons set forth in Paragraph 3 of the last Office action (paper mailed March 23, 2006).

Applicant's remarks in the response filed September 12, 2006 have been carefully considered but are not found to be persuasive. Mikito Figure 6 clearly discloses the use of cylinder-type control means 40 for introduction of a multidirectional rod 38 into a workpiece cavity prior to forging and withdrawal of the rod subsequent to forging, as now required by the claims. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such means to insert and withdraw the multidirectional rods 63, 64 in Mikito Figure 8 in order to avoid the need for manual manipulation of cumbersome and/or heavy tool elements.

Hiroshi discloses forging a molded perform with maintaining the shape of molded cavities during the forging. As stated in the last Office action, whether the shape of the preformed cavities is reformed during the forging, as shown in Figures 8 and 9 of Mikito, or maintained in the molded shape, as in Hiroshi, is considered to be an obvious exercise of mechanical design depending on the complexity and location of the cavity profile desired in the product, and not a patentable distinction absent a disclosure of

criticality in the solution of stated problems with the formation of a molded cavity and subsequent product recess having a specific profile. It would be particularly obvious to form a molded cavity having the desired final profile in an instance where subsequent forging is applied at a perform location which is remote from the location of the cavity, as shown by Hiroshi Figures 3 and 4 where the cavities are adjacent one end of the molded perform and the heading is performed adjacent the other end.

Applicant's response refers to the forging preform of Mikito has being semi-liquid or pasty. It is noted, however, that the Mikito perform is a self-sustaining shape prior to be placed in the forging die, and, further, that Applicant has no disclosure of heating the preform to any specific condition prior to forging. Thus, the fact that the Mikito perform may be in a "pasty" condition at the time of forging is not considered to be relevant to these claims.

Claim Rejections - 35 USC § 102

3. Claims 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Mikito.

Figure 6 of Mikito discloses a forging die having cylinder-type control means 40 for translating a multidirectional rod 38 into a preformed workpiece cavity 34, as required by these claims. Whether the workpiece cavity is reshaped in the forging or maintained in shape, as required by Claim 1, is immaterial in a claim to the die itself since the die structure is not limited by the characteristics of the forging perform.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

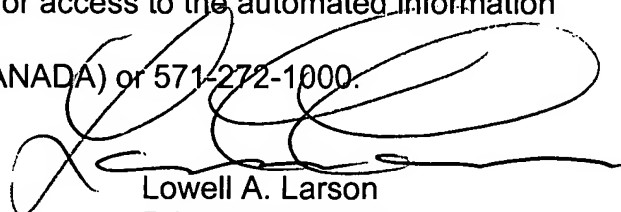
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lowell A. Larson whose telephone number is (571) 272-4519. The examiner can normally be reached from M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Lowell A. Larson', is written over a horizontal line.

Lowell A. Larson
Primary Examiner
Art Unit 3725

LAL
October 16, 2006